

Amendment/Response

Reply to Office Action of February 23, 2007

REMARKS/DISCUSSION OF ISSUES

Claims 1-24 are pending in this application. No claims are amended or cancelled.

Rejections under 35 U.S.C. § 103(a)

Claims 1-24 are rejected under U.S.C. § 103(a) as being unpatentable over Pan et al. in view of Allam et al. The rejection of the claims is respectfully traversed.

Argument 1: All elements of the claimed invention are not found in the combination.

Pan et al. does not disclose translated text as that term would be understood by one having ordinary skill in the art of machine translation systems. MPEP Section 2111 states the following in the discussion of interpreting claims their broadest reasonable construction:

"The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1)."

Throughout the specification, "text" is used in the context of multiple words. Page 1, lines 5-7 of the specification do not make sense if "text" can mean one word. This usage is consistent throughout the specification. For example, page 7, lines 18-22 of the specification makes it clear that there is a distinction between one word and "text."

This is also consistent with normal dictionary usage. The Encarta Dictionary, which is accessible on-line using the "tools" Research" menus from MSWord defines "text" (second meaning) as " words that have been written down, typed, or printed." None of the other meanings in the Encarta Dictionary contradict this definition.

Amendment/Response

Reply to Office Action of February 23, 2007

Therefore, Pan et al. does NOT disclose the element of "a translated text creator." In fact, Pan et al. recognizes that their invention is not a machine translation system in column 14, lines 65-67, where the reference states, "By combining the method of this invention with a web page translation service, it is possible to . . .", which further emphasizes the point that Pan et al. does not contain a translated text creator as that element is defined in the claims and specification of the instant invention.

Because the combination of the references does not disclose or suggest the claimed invention, it is respectfully suggested that the rejection is overcome. Reconsideration of the rejection of claims 1-24 under U.S.C. § 103(a) is respectfully requested.

Argument 2: Non analogous art.

The requirement still exists that the references used by the Examiner in making a rejection under Section 103(a) must be analogous prior art. As MPEP Section 2141.01(a) states,

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved)."

The Examiner has not stated why she believes that the references are from analogous art. The present invention relates to machine translation systems as stated in the specification, lines 3-5. Pan et al. relates to a method and system of information retrieval, and specifically to

Amendment/Response**Reply to Office Action of February 23, 2007**

providing query service in a native language for Internet users (col. 1, lines 6-10). Allam et al. relates to displaying and viewing electronic text (para. [0002]). Neither of these two references are in the Applicants' field of endeavor. Neither are they reasonably pertinent to the particular problem with which the inventor was concerned. The invention is directed to managing a situation where a word not registered in the dictionary being used for the text translation between two languages is encountered during the machine translation. Neither Pan et al. nor Allam et al. have a machine translation system, nor do they deal with an "unknown" word. Allam et al. does deal with an unfamiliar word by looking up the word in a dictionary, but the word is unfamiliar in the language being used by the user, not "unknown" in the sense of being unfamiliar with a word in a foreign language.

Because the references are not analogous art, any combination of them does not meet the requirements of MPEP Section 2141.01(a), and it is therefore respectfully suggested that the rejection is overcome. Reconsideration of the rejection of claims 1-24 under U.S.C. § 103(a) is respectfully requested.

Argument 3: No basis given for the motivation to combine references.

MPEP Section 2143.01 states in part, "In *In re Fine*, the claims were directed to a system for detecting and measuring minute quantities on nitrogen compounds comprising a gas chromatograph, a converter which converts nitrogen compounds into nitric oxide by combustion, and a nitric oxide detector. The primary reference disclosed a system for monitoring sulfur compounds comprising a chromatograph, combustion means, and a detector, and the secondary reference taught nitric oxide detectors. The examiner and Board asserted that it would have been within the skill of the art to substitute one type of detector for another in the system of the primary reference, however the court found there was no support or explanation of this conclusion and reversed."

It is respectfully suggested that the Examiner must do more than simply state a motive, but must also provide support or explanation of the conclusion that it would have been obvious to combine the features of the references. Applicants recognize that the motivation does not have to be found exclusively from within the references themselves, and can also be found from

Amendment/Response

Reply to Office Action of February 23, 2007

the general knowledge of one skilled in the art, but the Examiner is still required to state just where the motivation is found. The Examiner does refer to a specific place in Allam et al., but that only speaks in terms of finding definitions for unfamiliar terms not found in the built-in dictionary, and says nothing about a motivation to combine this feature from Allam et al. into a machine translation system. Because neither Pan et al. nor Allam et al. have anything to do with machine translation systems (as pointed out in Argument 2 above), it is not surprising that neither reference contains the motivation to combine. Where then does it come from? The Examiner does not say in her rejection. Thus we have a conclusory statement from the Examiner without objective examples to back it up. As the MPEP section quoted above makes clear, the law requires an explanation of the conclusion or it will not be upheld on appeal.

Applicants respectfully suggest that the rejection is overcome. Reconsideration of the rejection of claims 1-24 under U.S.C. § 103(a) is respectfully requested.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application in condition for allowance. If any points remain in issue that may be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated or by e-mail directed to Chris@PatentingServices.com.

Respectfully submitted,



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